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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,479	10/30/2000	Vance Bergeron	APV30270CIP	6625
77213 7590 06/12/2008 Novak Druce + Quigg, LLP 1300 Eye Street, NW, Suite 1000 Suite 1000, West Tower Washington, DC 20005				
EXAMINER				
CHEUNG, WILLIAM K				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/698,479

Applicant(s)

BERGERON ET AL.

Examiner

WILLIAM K. CHEUNG

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15, 17-41 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) 14, 15 and 19-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 17, 18 and 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/318,941.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The examiner acknowledges the receipt of the argument filed February 11, 2008. Claims 5, 16, 42 have been cancelled. Claims 1-4, 6-15, 17-41, 43-48 are pending. Claims 14-15, 19-41 are drawn to non-elected subject matter. Claims 1-4, 6-13, 17, 18, 43-48 are examined with merit.
2. In view of the argument filed February 11, 2008, the rejection of Claims 1-13, 17-18, 43 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fink et al. (US 4,542,175), is withdrawn.
3. In view of the argument filed February 11, 2008, the rejection of Claims 1-4, 6-13, 17, 18, 43-48 under 35 U.S.C. 112, second paragraph, relating to "molecular weights" is withdrawn temporarily. When the new matter "weight average" is removed, the 112 rejection relating to the argued "molecular weight" will be reinstated.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4, 6-13, 17, 18, 43-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 6 (line 3), claim 7 (penultimate line), the recitation "weight average" is considered "new matter" because the recited "weight average" is not supported by the original specification. Applicants are required to submit an amendment to remove the "new matter" added.

Applicant's arguments filed February 11, 2008 have been fully considered but they are not persuasive. Applicants argue that the Declaration filed May 4, 2007 is adequately to put to modify the original specification filed. However, the examiner disagrees. Regarding applicants' argument July 5, 2007 and Declaration filed May 4, 2007 that the molecular weight as claimed are weight average molecular weight by default, applicants fail to recognize that the specification and the original set of claims as written do not provide the support for such argument.

Applicants argue that the recited "weight average" is not considered "new matter" because it is inherent to a polymer to have "weight average" molecular weight. However, the examiner disagrees. Because applicants' specification fails to point out the type of molecular weight characterization is being used for the claimed invention, the examiner has a reasonable basis that that applicants fail to possess the claimed invention at the time of filing the instant application.

All percentages, ratios and proportions herein are by weight, unless otherwise
10 specified. All temperatures are in degrees Celsius (°C) unless otherwise specified. All
documents cited are in relevant part, incorporated herein by reference in their entirety.

Regarding applicants' argument that the specification (page 5, line 6-8) recite that "all percentages, ratios and proportion herein are by weight, unless otherwise specified" provides support for the claimed weight-average molecular weight, the examiner disagrees because applicants fail to recognize that the molecular weight of a polymer is neither percentages, ratio, nor proportion. Applicants must recognize that the argued "percentage, ratio, and proportion" are dimensionless. Since "Daltons" traditionally are units used for describing molecular weights of organic compounds, the examiner has a reasonable basis that the argued molecular weight in "daltons" are not weight-average molecular weights. Therefore, the examiner has a reasonable basis to believe that applicants' specification fails to provide support for the claimed "weight average molecular weight".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 6-13, 17, 18, 43-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (line 3), claim 2 (line 3), claim 3 (line 2), claim 4 (line 3-7), claim 6 (line 2-3), claim 7 (last two lines), claim 44 (line 2), the recitations "about" are considered indefinite because they fail to properly set the metes and bound of the claim.

Conclusion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/698,479

Page 6

Art Unit: 1796

/William K Cheung/

Primary Examiner, Art Unit 1796

William K. Cheung, Ph. D.

Primary Examiner

June 6, 2008